

REMARKS

I. Status of the Claims

Claims 1-71, 73, 74, 81-92, 94, and 95 are now pending. Claims 86-92 have been withdrawn from consideration as drawn to a non-elected species. Claims 72, 75-80 have been canceled without prejudice or disclaimer. Claims 1, 73, 74, 81, 82, 83, and 84 have been amended. Support for the amended claims can be found throughout the application as filed and is discussed further below. Accordingly, no issue of new matter is raised by these amendments.

II. Personal Interview

Applicants respectfully thank Examiner Yu and Supervisor Dr. Padmanabhan for the courtesies extended to Applicants' representatives Thalia Warnement and Mareesa Frederick during the personal interview on June 5, 2003.

After hearing Applicants' arguments, the Examiner advised Applicants that the 35 U.S.C. § 103(a) rejections may be overcome by amending the independent claims to include the limitations of original claim 72, with the exclusion of washing compositions. Accordingly, this Amendment has been filed solely to advance the prosecution of the pending claims.

III. Rejections Under 35 U.S.C. § 103(a)

As every Examiner is well-aware, the Office carries the initial burden of establishing a prima facie case of obviousness under § 103(a). In so doing, the Examiner must demonstrate, among other criteria, that some suggestion or motivation

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1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
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exists, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. § 2143. In this case, the Examiner has failed to set forth sufficient evidence to satisfy this criterion for each of the § 103(a) rejections, as discussed below.

A. Glenn in view of Dalle

The Examiner has rejected claims 1-16, 44-51, 60, 65-71, 82-85, 94 and 95 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,885,948 to Glenn et al. ("Glenn") in view of EP 0874017 to Dalle et al. ("Dalle"). Applicants respectfully traverse the rejection for the reasons of record and those presented below.

The Examiner alleges that *Glenn* teaches skin cleansing compositions comprising synthetic oils such as hydrogenated polyisobutene and synthetic polyalkylenes, anionic and amphoteric surfactants, and silicone oils such as polysiloxane. *Office Action*, p. 3. The Examiner admits, however, that *Glenn* fails to teach the specific type of polysiloxane recited in the present claims. *Id.* Thus, she relies on the teachings of *Dalle* to cure this deficient disclosure. *Id.* at 3-4. She concludes that it would have been obvious to modify *Glenn*'s compositions by adding *Dalle*'s polysiloxane copolymers. She finds support for this modification in *Dalle* and in "the expectation of successfully producing a cleansing/moisturizing dual-functioning composition which provide[s] smoothness and improved properties." *Id.* at 4. Applicants respectfully disagree with the Examiner's rejection.

First, neither *Glenn* nor *Dalle* provide the necessary motivation for one of skill in the art to combine these references to attain the presently claimed invention. As amended, the present claims recite that the composition be provided in various forms,

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202.408.4000
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for example, a composition for straightening the hair, a composition for dyeing the hair, or a composition for bleaching the hair. See, e.g., amended Claim 1. Glenn, however, is specifically directed to a dual cleansing and lipid moisturizing liquid composition. *Glenn*, col. 1, lines 11-12. Indeed, the *Glenn* inventors mainly endeavored to find an effective composition with this dual capability:

It is an object of the present invention to provide an effective, yet gentle, dual skin cleansing liquid composition which actually deposit enough lipid on the skin to provide superior skin moisturizing and sensory benefits while maintaining its lathering and cleaning properties.

Col. 2, lines 11-15. Thus, nothing in *Glenn* would have motivated one skilled in the art to provide a composition in a form other than a dual cleansing and moisturizing composition. Moreover, as amended, the present claims exclude washing or cleansing compositions, thus *Glenn* clearly cannot serve as a basis to deny patentability.

Further, even if the *Glenn* is considered in conjunction with *Dalle*, these references still do not render the present claims obvious. Although *Dalle* does suggest that its claimed polysiloxane can be used in various applications, it merely discloses a list of "standard applications for silicone emulsions." *Dalle*, line 47. These standard applications include, for example, skin creams, bath oils, and hair shampoos. See lines 47-57. Applicants respectfully submit that such a generic and broad disclosure neither explicitly or implicitly suggests the presently claimed invention.

Moreover, Applicants submit that *Glenn* teaches away from the Examiner's proposed modification. *Glenn* teaches that only certain types of lipid skin moisturizing agents can be used in its compositions. It states that:

In this invention the lipid skin moisturizing agent is defined with scrutiny. The lipid type and its physical properties in this present invention hold the key to the overall product effectiveness, and is restricted to a hydrophobic material with [certain] rheological properties.

Glenn, col. 8, lines 50-53. Thus, the type of moisturizing agent is a critical parameter in *Glenn*'s compositions. This fact would have suggested to one skilled in the art that only those agents specifically disclosed in *Glenn* would be suitable. Accordingly, one skilled in the art would not have had any motivation to modify *Glenn* by incorporating various types of polysiloxanes other than the ones specifically disclosed by *Glenn*. Thus, for at least these reasons, Applicants respectfully request that the Examiner withdraw the rejection.

B. *Glenn* in view of *Dalle* and further in view of *Dubief*

The Examiner has rejected claims 52-59 and 61-64 as unpatentable under 35 U.S.C. § 103(a) over *Glenn* and *Dalle* as applied above and further in view of U.S. Patent No. 5,690,920 to Dubief et al. ("*Dubief*"). Applicants respectfully disagree with this rejection for the reasons presented below.

The Examiner admits that both *Dalle* and *Glenn* fail to teach the surfactants recited in claims 52-59 and 61-64. Thus, she relies on *Dubief* to cure this deficiency. However, as discussed above, one of ordinary skill in the art would not have been motivated to modify the *Glenn* reference by incorporating *Dalle*'s (or any other) polysiloxanes. Thus, *Dubief*, as relied on by the Examiner for its teachings of the presently claimed surfactants, is irrelevant because this reference fails to cure the

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fundamental deficiencies of the underlying references. Thus, for at least this reason, Applicants respectfully request that the Examiner withdraw the rejection.

Moreover, similar to *Glenn*, *Dubief* is directed to a "foamable washing composition for hair and skin care," a type of composition excluded by the present amendment. See *Dubief Abstract*. Thus, given that *Dubief* solely discloses washing compositions, one would not have been motivated to combine this reference with the teachings of *Glenn* and *Dalle*.

Finally, *Dubief* is drawn to compositions comprising certain water-soluble silicones, at least one alkylpolyglycoside as a dispersing agent, and a detergent. *Dubief*, col. 1, lines 27-29. *Dubief* discloses that its compositions may further comprise other surface active agents other than the alkylpolyglycoside disclosed. *Id.*, col. 4, lines 22-26. It then teaches four broad classes of the various agents that can be used in its compositions. *Id.*, col. 4, line 27 to col. 5, line 41. Based on this disclosure, the Examiner summarily concludes that:

It would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the composition of the combined references by substituting the detergents of *Glenn* with the conventional surfactants as motivated by *Dubief*, because of the expectation to have produced shower or bath composition with similar cleansing and moisturizing effects.

Office Action, p. 4.

Dubief, however, discloses a composition comprising a specific combination of components that may optionally include these additional agents. Thus, one skilled in the art would not have been motivated to select these agents, out of context, to incorporate into *Glenn's* compositions. It is clear that the Examiner has simply taken

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1300 I Street, NW
Washington, DC 20005
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the position that the combination of known elements, even if each element is plucked from a reference out of the context in which it is taught, is *prima facie* obvious. This, however, is not the law. Thus, Applicants respectfully request that the rejection be withdrawn for this additional reason.

C. *Iwao* in view of *Dalle*

The Examiner has also rejected claims 1-17, 25, 27, 44-46, 56, 70-74, 81-84, 94, and 95 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 4,183,917 to Iwao et al. ("Iwao") in view of *Dalle*. Applicants respectfully disagree with this rejection as well.

The Examiner alleges that *Iwao* teaches hair conditioner compositions comprising synthetic oils, such as alpha-olefin polymers, quaternary ammonium salts, and nonionic surfactants. *Office Action*, p. 5. The Examiner admits that *Iwao* fails to teach the presently claimed polysiloxane, therefore she again cites *Dalle* to make up for this deficiency. *Id.* The Examiner contends that it would have been obvious to have modified the composition of *Iwao* by adding *Dalle*'s silicone copolymer emulsion. *Id.* She alleges that *Dalle* provides the motivation for the proposed modification because of the "expectation of successfully producing hair conditioner composition[s] which provide enhanced conditioning benefits to the hair." *Id.* at 6.

Applicants contend that the Examiner has not set forth sufficient evidence to justify the proposed modification, as *Dalle*, alone or even combined with *Iwao*, does not support the alleged modification. See *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999) (requiring a "clear and particular" suggestion to combine prior art references). The Examiner urges that *Dalle* provides the necessary motivation to modify *Iwao* by

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1300 I Street, NW
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incorporating its silicone emulsions into *Iwao*'s compositions, however, Applicants believe the Examiner has overstated the teachings of *Dalle*.

Dalle teaches only a method of making silicone in water emulsions, thus, nothing in this disclosure even remotely suggests the use of its silicone/water emulsions with *Iwao*'s synthetic oils. *Dalle* does disclose that its emulsions can also include surfactants and other optional ingredients such as perfumes and thickeners, however, it notably does not teach the presently claimed synthetic oils. Thus, contrary to the Examiner's allegation, *Dalle* does not provide the necessary motivation needed to make the proposed modification.

Moreover, in Applicants' view, nothing in *Iwao* suggests the desirability of making such a modification. Indeed, simply because *Iwao* can be modified as suggested by the Examiner does not make the alleged modification obvious unless the prior art also suggests the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1994). Although *Iwao* does disclose that a silicone such as dimethylpolysiloxane or methylphenylpolysiloxane can be used in its compositions, these polymers are only disclosed as optional ingredients. *Iwao*, col. 3, lines 60-62. Thus, one skilled in the art would not have been motivated to search for suitable replacements for this optional ingredient.

In fact, *Iwao* primarily touts the advantages of liquid ester oil as an optional ingredient, thus making the Examiner's alleged modification even more implausible. *Iwao* teaches that the addition of liquid ester oil "can further improve the use effect (such as retention of conditioning effect or hair fixing effect) as well as the feeling of use of the hair conditioner composition." *Id.*, col. 3, lines 17-21. Thus, given this favorable

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1300 I Street, NW
Washington, DC 20005
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disclosure, why would one seek to incorporate *Dalle*'s silicone emulsions, particularly in light of the fact that *Iwao* only generally discloses the optional use of silicones in its compositions.

Thus, neither *Iwao* nor *Dalle* teach or suggest the desirability of the modification the Examiner proposes to obtain the claimed invention. Although these references may demonstrate that individual components of the present invention are known, this fact, by itself, cannot be used to establish a *prima facie* case. See M.P.E.P. § 2143.01 (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998)). Thus, for at least these reasons, Applicants respectfully request that the Examiner withdraw this rejection.

D. *Iwao* and *Dalle* in view of *Restle*

Finally, the Examiner has rejected claims 18-24, 26, 28-43, 47-51, 60, 65-69, and 75-80 under 35 U.S.C. § 103(a) as unpatentable over *Iwao* and *Dalle* and further in view of U.S. Patent No. 6,039,936 to Restle et al. ("*Restle*"). Applicants respectfully traverse this rejection.

Because both *Iwao* and *Dalle* fail to teach all the specific surfactants recited in the present claims, the Examiner relies on the teachings of *Restle* to provide this missing disclosure. Specifically, the Examiner alleges that *Restle* teaches cosmetic oil-in-water emulsions comprising nonionic amphiphilic lipids, cationic amphiphilic lipids, and synthetic essential oils. *Office Action*, p. 6. The Examiner further notes that *Restle* teaches that the advantages of its compositions include enhanced penetration of active ingredients on hair and glossy appearance without greasy feel and softness. *Id.* Based on these teachings, the Examiner concludes that it would have been obvious to

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DUNNER LLP

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Washington, DC 20005
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substitute the cationic surfactants disclosed in *Iwao* with *Restle*'s cationic amphiphilic lipids based on the expectation of a similar glossy appearance and softness to the hair. *Id.* p. 7.

First, as discussed above, one of ordinary skill in the art would not have been motivated to modify the teachings of *Iwao* by incorporating *Dalle*'s polysiloxanes. Accordingly, *Restle*, as relied up on by the Examiner for its alleged teaching of cationic amphiphilic lipids, fails to cure the deficiencies of the underlying references. Thus, the Examiner's alleged modification cannot render the presently claimed invention obvious and, for at least this reason, Applicants respectfully request that the Examiner withdraw this rejection.

Second, Applicants contend that nothing in *Restle* suggests the obviousness of the alleged substitution of *Iwao*'s cationic surfactants with *Restle*'s cationic amphiphilic lipids. As noted above, the Examiner's basis for this substitution lies in the expectation of providing a similar glossy appearance and softness to the hair. *Office Action*, p. 7. However, *Restle* teaches the advantages of its claimed combination of a non-ionic amphiphilic lipid and at least one cationic amphiphilic lipid. *Restle* attributes no favorable properties to the cationic amphiphilic lipids alone. Thus, one skilled in the art would not have arbitrarily sought to isolate this lipid to use in *Iwao*'s compositions. Accordingly, Applicants respectfully request that this rejection be withdrawn.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Thalia V. Warnement
Reg. No. 39,064

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com